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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,529	02/20/2001	Kazuhiro Kawabata	DAIN:577	5187

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EXAMINER

BAKER, CHARLOTTE M

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/785,529

Applicant(s)

KAWABATA, KAZUHIRO

Examiner

Charlotte M Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                               |                                                                                        |
|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/14/01</u> . | 6) <input type="checkbox"/> Other: ____                                                |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on 02/20/01 is being considered by the examiner.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5, 12, and 13 are rejected under 35 U.S.C. 102(e) as being unpatentable by Tipirneni (6,381,029).

**Regarding Claim 1:** Tipirneni discloses a camera system capable of digitizing images (column 3, lines 13-16), which reads on “photographic image reading means for reading a photographic image datum”; an operator enters data related to the images (column 4, lines 43-51), which reads on “personal data inputting means for classifying personal information on said photographic image datum, which is read by said photographic image reading means, to input the classified personal information as a personal datum”; images managed and security measures (column 4,

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lines 59-67 and column 6, lines 58-67 and column 7, lines 1-7), which reads on “photographic image managing means for storing said photographic image datum and said personal datum and for retrieving and extracting a photographic image datum meeting required conditions, on the basis of said personal datum”; a program that retrieves the selected images based upon permission criteria (column 6, lines 12-22), which reads on “use consent advisability registering means for registering advisability of permission for third parties to use said photographic image datum which is read by said photographic image reading means”; image file transmitted (column 3, lines 23-27), which reads on “output means for outputting said photographic image datum which is read by said photographic image reading means”; restricting viewing of images based upon permission granted (column 6, lines 12-22 and column 6, lines 58-67 and column 7, lines 1-7 and column 7, lines 31-34 and column 7, lines 56-65), which reads on “wherein said photographic image managing means manages said photographic image datum so that a photographic image datum, which has been registered so as to give permission for third parties to use the photographic image datum, among a plurality of photographic image data which has been read by said photographic image reading means, can be taken out by persons concerned with an owner of the registered photographic image datum of third parties”.

**Regarding Claim 5:** Tipirneni satisfies all the elements of Claim 1. Tipirneni further discloses a camera system with a digital camera and image storage (column 3, lines 48-55), which reads on “wherein said photograph image reading means reads a photograph image datum, which has been picked up by a digital camera to be stored in a data storage medium, from said data medium”.

**Regarding Claim 12:** Tipirneni discloses a camera system capable of digitizing images (column 3, lines 13-16), which reads on “reading a photographic image datum”; a program that retrieves the selected images based upon permission criteria (column 6, lines 12-22), which reads on “registering advisability of permission for third parties to use the read photographic image datum”; images managed and security measures (column 4, lines 59-67 and column 6, lines 58-67 and column 7, lines 1-7), which reads on “storing a photographic image datum, which is registered”; restricting viewing of images based upon permission granted (column 6, lines 12-22 and column 6, lines 58-67 and column 7, lines 1-7 and column 7, lines 31-34 and column 7, lines 56-65), which reads on “so as to give permission for third parties to use the photographic image datum, among a plurality of read photographic image data, together with a personal datum which is obtained by classifying personal information on the read photographic image datum, in a data base”; image file transmitted (column 3, lines 23-27), which reads on “outputting the read photographic image datum”.

**Regarding Claim 13:** Tipirneni satisfies all the elements of Claim 12. Tipirneni further discloses images managed and security measures (column 4, lines 59-67 and column 6, lines 58-67 and column 7, lines 1-7), which reads on “a step of retrieving and extracting a photographic image datum meeting required conditions, from the read photographic image data, which has been stored in said data base, on the basis of said personal datum”.

5. Claims 6 and 14 are rejected under 35 U.S.C. 102(e) as being unpatentable by Sharir et al. (6,297,853).

**Regarding Claim 6:** Sharir et al. discloses a scanner/digitizer to create images (column 7, lines 15-16), which reads on “photographic image reading means for reading a photographic image datum”; an advertisement arrangement database (column 9, lines 26-31), which reads on “advertisement image managing means for storing an advertisement image datum and for selecting and extracting an advertisement image datum meeting required conditions”; a video output (column 9, lines 54-56) and managing advertisement images (column 9, lines 47-53) and including images in the advertisement image (column 9, lines 26-35), which reads on “output means for outputting said photographic image datum, which is read by said photographic image reading means, together with said advertisement image datum which is extracted by said advertisement image managing means”.

**Regarding Claim 14:** Sharir et al. discloses a scanner/digitizer to create images (column 7, lines 15-16), which reads on “reading a photographic image datum”; an advertisement arrangement database (column 9, lines 26-31), which reads on “selecting and extracting an advertisement image datum meeting required conditions, from a plurality of advertisement image data which has been stored in a data base”; a video output (column 9, lines 54-56) and managing advertisement images (column 9, lines 47-53) and including images in the advertisement image (column 9, lines 26-35), which reads on “outputting the read photographic image datum, together with the extracted advertisement image datum”.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tipirneni in view of Brady et al. (6,647,372).

**Regarding Claim 2:** Tipirneni satisfies all the elements of Claim 1. Tipirneni fails to specifically address a store server and a center server. Brady et al. disclose a system that utilizes a store server and a central server (column 4, lines 40-60), which reads on “wherein said photographic image reading means, said personal data inputting means, said use consent advisability registering means and said output means are provided in a store server, and said photographic image managing means is provided in a center server which is connected to said store server via a network”. It would have been obvious for a person of ordinary skill in the art at the time of the invention to include the suggestion of Brady et al. to avoid wasting time during the customer transaction period.

**Regarding Claim 3:** Tipirneni satisfies all the elements of Claim 1. Tipirneni fails to specifically address fee paying. Brady et al. disclose a customer payment screen (column 11, lines 5-10), which reads on “fee paying means for executing a fee paying processing, wherein said output means outputs said photographic image datum after the fee paying processing is executed by said fee paying means”. It would have been obvious for a person of ordinary skill in the art at the time of the invention to include the suggestion of Brady et al. to avoid idle time when neither the customer nor the store benefits.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tipirneni in view of Brady et al. and further in view of DiRienzo (6,006,191).

permission to third parties. DiRienzo discloses a fee schedule that the patient chooses for viewing their images (column 24, lines 7-11), which reads on “wherein said fee paying means changes setting of a fee in accordance with the advisability of permission for third parties to use, which has been registered by said use consent advisability registering means”. It would have been obvious for a person of ordinary skill in the art at the time of the invention to use the suggestion of DiRienzo to enable remote access of images for rapid assessment and to enable the patient to decide upon a third party commensurate with a particular fee.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir et al. in view of Kanevsky et al. (6,334,109).

**Regarding Claim 7:** Sharir et al. satisfy all elements of Claim 6. Sharir et al. fail to specifically address a store server with an advertisement server. Kanevsky et al. disclose a local shopping center server (column 5, lines 11-17) and advertisement server (column 5, lines 18-32), which reads on “wherein said photographic image reading means and said output means are provided in a store server, and said advertisement image managing means is provided in an advertisement server which is connected to said store server via a network”. It would have been obvious to a person skilled in the art at the time of the invention to include the suggestion of Kanevsky et al. to provide a system for using devices with displays for distributing personalized advertisements.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir et al. in view of Ferguson et al. (5,819,092).

**Regarding Claim 8:** Sharir et al. satisfy all elements of Claim 6. Sharir et al. fail to specifically address a fee associated with an advertisement image and photo image. Ferguson et al. disclose a fee associated with a graphic image in an advertisement (column 29, lines 66-67 and column



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30, lines 1-10) and fee processing (column 29, lines 45-55), which reads on “fee paying means for executing a fee paying processing, wherein said output means outputs said photographic image datum together with said advertisement image datum after said fee paying processing is executed by said fee paying means”. It would have been obvious for a person of ordinary skill in the art at the time of the invention to include the suggestion of Ferguson et al. to use a fee structure capable of handling both fees levied against users and third party content providers.

11. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir et al. in view of Tipirneni.

**Regarding Claim 9:** Sharir et al. satisfy all elements of Claim 6. Sharir et al. fail to specifically address classification of personal information. Tipirneni discloses an operator entering data related to the images (column 4, lines 43-51), which reads on “personal data inputting means for classifying personal information on said photographic image datum, which is read by said photographic image reading means, to input the classified personal information as a personal datum”. Sharir et al. further disclose an advertisement arrangement database (column 9, lines 26-31), which reads on “wherein said advertisement image managing means retrieves and extracts an advertisement image datum on the basis of said personal datum which is inputted by said personal data inputting means”. It would have been obvious for a person of ordinary skill in the art at the time of the invention to combine the teachings of Tipirneni and Sharir et al. to allow viewing of images in a secure manner.

**Regarding Claim 10:** Sharir et al. satisfy all elements of Claim 6. Sharir et al. fail to specifically address a digital camera. Tipirneni discloses a camera system with a digital camera and image storage (column 3, lines 48-55), which reads on “wherein said photograph image

reading means reads a photograph image datum, which has been picked up by a digital camera to be stored in a data storage medium, from said data medium”.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir et al. in view of Dobbs et al. (4,352,555).

**Regarding Claim 11:** Sharir et al. satisfy all elements of Claim 6. Sharir et al. fail to specifically address printing a photographic image and an advertisement image in a predetermined format. Dobbs et al. disclose a magazine cover with a chosen image (column 4, lines 52-67 and column 5, lines 1-6), which reads on “wherein an output matter outputted from said output means is a printed matter on which a photographic image and an advertisement image are laid out in accordance with a predetermined format”.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmb *CMB*

*KA Williams*

**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**